

ESTTA Tracking number: **ESTTA733610**

Filing date: **03/15/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	BBK Tobacco & Foods, LLP
Granted to Date of previous extension	03/23/2016
Address	3401 W Papago St Phoenix, AZ 85009 UNITED STATES

Attorney information	Brendan N. Mahoney, Esq. 3401 W Papago St Phoenix, AZ 85009 UNITED STATES legal@hbiin.com Phone:602-374-7482
----------------------	--

Applicant Information

Application No	86687407	Publication date	11/24/2015
Opposition Filing Date	03/15/2016	Opposition Period Ends	03/23/2016
Applicant	Elementiumlighter.Com LLC 1732 Eisenhower St. San Mateo, CA 94403 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. First Use: 2014/04/20 First Use In Commerce: 2014/04/20 All goods and services in the class are opposed, namely: USB rechargeable electronic cigarette lighters

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------


Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	4668271	Application Date	06/28/2013
Registration Date	01/06/2015	Foreign Priority Date	NONE
Word Mark	ELEMENTS		

Design Mark	ELEMENTS
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 2014/05/19 First Use In Commerce: 2014/05/19 Electronic cigarette lighters; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic cigars; Smokeless cigar vaporizer pipes; Smokeless cigarette vaporizer pipe


U.S. Registration No.	3471137	Application Date	11/15/2007
Registration Date	07/22/2008	Foreign Priority Date	NONE
Word Mark	ELEMENTS		
Design Mark	Elements		
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1996/01/10 First Use In Commerce: 1996/01/10 Cigarette ash receptacles; Cigarette lighters not of precious metal; Cigarette papers; Cigarette rolling machines; Cigarette rolling papers; Cigarette-rolling machines; Filter tips for cigarettes; Lighters for smokers; Machines allowing smokers to make cigarettes by themselves; Pocket apparatus for rolling cigarettes; Pocket apparatus for self-rolling cigarettes; Pocket appliances for rolling one's own cigarettes; Pocket devices for self-rolling of cigarettes; Pocket machines for rolling cigarettes; Pocket-size cigarette rolling machines; Matches		


U.S. Registration No.	4229954	Application Date	03/19/2012
Registration Date	10/23/2012	Foreign Priority Date	NONE
Word Mark	ELEMENTS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 1996/01/10 First Use In Commerce: 1996/01/10 Cigarette rolling machines; Cigarette rolling papers; Filter tips

U.S. Application No.	86634852	Application Date	05/19/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ELEMENTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 0 First Use In Commerce: 0 Providing consumer and business information and related news in the fields of marijuana and cannabis and medicinal and therapeutic marijuana and cannabis		

U.S. Application No.	86305866	Application Date	06/10/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ELEMENTS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 1996/01/10 First Use In Commerce: 2014/06/09 Smoking pipes; Tobacco pipes

U.S. Application No.	86634751	Application Date	05/19/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ELEMENTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 0 First Use In Commerce: 0 Herbs for smoking		

Attachments	85973315#TMSN.png(bytes) 77330440#TMSN.png(bytes) 85573306#TMSN.png(bytes) 86634852#TMSN.png(bytes) 86305866#TMSN.png(bytes) 86634751#TMSN.png(bytes) Elementiumlighters notice of opposition.pdf(62252 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Brendan Mahoney/
-----------	-------------------

Name	Brendan N. Mahoney, Esq.
Date	03/15/2016

1. Opposer is the current owner of the following U.S. Patent and Trademark Office ("PTO") registrations for the following trademarks (collectively "Opposer's Registered Marks"):

Mark	Class & Goods	Serial No.	Reg. No.	File Date	First Use
Elements	034 - Smoking pipes; Tobacco pipes	86-305866		6/10/14	6/9/14
Elements	034 - Cigarette ash receptacles; Cigarette lighters not of precious metal; Cigarette papers; Cigarette rolling machines; Cigarette rolling papers; Cigarette-rolling machines; Filter tips for cigarettes; Lighters for smokers; Machines allowing smokers to make cigarettes by themselves; Pocket apparatus for rolling cigarettes; Pocket apparatus for self-rolling cigarettes; Pocket appliances for rolling one's own cigarettes; Pocket devices for self-rolling of cigarettes; Pocket machines for rolling cigarettes; Pocket-size cigarette rolling machines; Matches	77-330440	3471137	11/15/07	1/10/96
Elements	034 - Cigarette rolling machines; Cigarette rolling papers; Filter tips	85-573306	4229954	3/19/12	1/10/96
Elements	034 - Electronic cigarette lighters; Electronic cigarettes; Electronic cigarettes for use as an alternative to traditional cigarettes; Electronic cigars; Smokeless cigar vaporizer pipes; Smokeless cigarette vaporizer pipe	85-973315	4668271	6/28/13	5/19/14
Elements	034 - Herbs for smoking	86-634751		5/19/15	
Elements	035 - providing consumer and business information and related news in the fields of marijuana and cannabis and medicinal and therapeutic marijuana and cannabis	86-634852		5/19/15	

2. Opposer uses, and has used, and continues to use Opposer's Registered Marks to identify the goods identified in the registrations for Opposer's Registered Marks.

3. Opposer itself, or through its predecessor, has used, Opposer's Registered Marks in U.S. interstate commerce for the sale of the goods identified in those registrations since 1996.

4. Applicant is seeking to obtain, under the provisions of the Trademark Act of 1946, as amended, registration upon the Principal Register of Applicant's Mark.

5. Applicant filed an Express Abandonment on November 18, 2014. Nevertheless, Applicant's Mark was published for opposition in the Official Gazette of November 24, 2015.

6. Applicant's Mark contains word elements that are identical or closely similar to the Opposer's Registered Marks.

7. Applicant's Mark duplicates distinctive characteristics of the Opposer's Registered Marks.

8. Applicant's Mark creates an overall commercial impression identical to Opposer's Registered Marks.

9. Applicant's Mark is confusingly similar to Opposer's Registered Marks.

10. Applicant's Mark is used in connection with the sale of goods that are identical to, or related in some manner to, goods that are identified in the PTO registrations for Opposer's Registered Marks and that are sold by Opposer using Opposer's Registered Marks such that the goods are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source

11. Applicant's Mark creates the immediate and erroneous suggestion and impression that goods sold under Applicant's Mark are goods that originate with, are endorsed by, are compatible with, or are otherwise connected to Opposer.

12. Upon information and belief, the goods, identified in the application for Applicant's Mark, are and will be marketed under conditions such that they are likely to be encountered by the same purchasers of Opposer's goods, sold using Opposer's Registered Marks, and under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that the goods originate from the same source.

13. Upon information and belief, the customers of and the channels of distribution employed by Opposer and Applicant are likely to be similar, even overlapping, adding to the likelihood that the goods sold by Applicant under Applicant's Mark will be confused with the Opposer's goods, sold using Opposer's Registered Marks.

14. Upon information and belief, the classes of purchasers to whom Opposer and Applicant will sell will be the same, adding to the likelihood that consumers intent on purchasing Opposer's goods sold using Opposer's Registered Marks will purchase Applicant's goods sold under the Applicant's Mark under the mistaken impression that they originate with, are endorsed by, or are otherwise connected to Opposer.

15. The similar nature of the marks themselves, the related goods and the trade channels and customers for those goods are so great as to create a likelihood of confusion among consumers as to the source of Applicant's goods or Applicant's affiliation or relationship with, or sponsorship by, Opposer.

16. Such confusion resulting from Applicant's intended use and the requested registration of Applicant's Mark, will damage Opposer.

17. Applicant's Mark should be barred from registration, pursuant to 15 U.S.C. § 1052(d), because Applicant's Mark consists of a mark which so resembles Opposer's Registered Marks in use in U.S. interstate commerce, that Applicant's Mark is likely, when used on or in connection with the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive.

18. WHEREFORE, Opposer requests that its Opposition be sustained, that the registration of Applicant's Mark be refused, and that Application Serial No. 86-687407 be rejected.

Dated this 16th day of March, 2016

BBK TOBACCO & FOODS, LLP

A handwritten signature in black ink, appearing to read 'B. Mahoney', is written over a horizontal line.

Brendan N. Mahoney
General Counsel
3401 West Papago Street
Phoenix, AZ 85009

ATTORNEY FOR OPPOSER

CERTIFICATION

I certify that a copy of the foregoing Petition for Cancellation was sent this 16th day of March 2016 via United States mail, postage prepaid, to:

Elementiumlighter.com, LLC
1732 Eisenhower St
San Mateo, CA 94403

support@elementiumlighter.com

Jamie Sheldon
Attorney at Law
1760 Suite F, PMB No. 220
Airline Highway
Hollister, CA 95023

justtrademarks@gmail.com



Brendan N. Mahoney